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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
ABRISHAMKAR, KAVEH				
ART UNIT		PAPER NUMBER		
2131				
NOTIFICATION DATE		DELIVERY MODE		
05/20/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/614,036

**Applicant(s)**

SAITO ET AL.

**Examiner**

KAVEH ABRISHAMKAR

**Art Unit**

2131

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3, 4, 6 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-4, 6, and 9-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 29, 2008 has been entered.
2. Claims 3-4, 6, and 9-15 are currently pending consideration.

### ***Response to Arguments***

Applicant's arguments filed February 29, 2008 have been fully considered but they are not persuasive for the following reasons:

Regarding claim 3, the Applicant argues that the Cited Prior Art (CPA), Weiler et al. (U.S. Patent No. 6,725,205), does not teach "the designated program is automatically executed by the recording/reproducing apparatus in response to the medium identification information being detected on the recording medium." This argument is not found persuasive. The Applicant argues that the CPA teaches that the software is only executed once the hard disk drive is determined to have the same serial number as the data recording medium. However, there is no limitation that states that the automatic execution is only performed upon the detection of the medium identification information on the recording medium. In the CPA, the software is installed

automatically once the serial numbers are compared. This comparison includes the detection of the serial number on the recording medium (column 4, lines 32-35). Therefore, the system does automatically executed the program in response to detecting the serial number (medium identification) on the recording medium because without this detection, there would be no comparison, and the software would not be automatically executed. Therefore, the arguments are not found persuasive, and the rejection is given below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 3-4, 6, 9, and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Weiler et al. (U.S. Patent 6,725,205).

Regarding claim 3, Weiler discloses:

A data recording medium for use with a recording/reproducing apparatus, comprising:

a medium identification information unique to the data recording medium recorded thereon (column 4 lines 10-18), *wherein the software serial number is recorded on the medium to identify the installation software;*

a plurality of programs recorded on the data recording medium, wherein the medium identification information includes information with which one of the plurality of programs is designated (column 4 lines 26-33), *wherein the serial number associates a particular software with a particular system;*

a starting program, recording on the data recording medium, configured to cause a program of the plurality of programs, designated by the medium identification information, to automatically execute (column 5 lines 42-50, column 6 lines 44-54), *wherein if the disk drive serial number (hardware identification number) is the same as the target serial number (medium identification number) stored on the medium then the software is installed;* and

wherein the designated program is automatically executed by the recording/reproducing apparatus in response to the medium identification information being detected on the data recording (column 4, lines 10-35), *wherein in response to the detection of the medium identification information (serial number) on the data recording medium (software distribution medium) that the designated program (upgraded or new software program) is executed (installed).*

Claim 4 is rejected as applied above in rejecting claim 3. Furthermore, Weiler discloses:

The data recording medium as set forth in claim 3, wherein the data recording medium is bundled with a hardware device (column 5 lines 42-50, column 6 lines 44-54), *wherein if the disk drive serial number (hardware identification number) is the same as the target serial number (medium identification number) stored on the medium then the software is installed.*

Regarding claim 6, Weiler discloses:

A program starting method for executing a program recorded on a recording medium, comprising:

obtaining medium identification information (column 6 lines 44-54), *wherein the serial numbers between the software medium (medium identification) and the hard disk drive (hardware identification) are compared;*

determining a type that the medium identification information represents (column 6 lines 44-54), *wherein the serial numbers between the software medium (medium identification) and the hard disk drive (hardware identification) are compared to discover if the serial numbers are matched between the type of software and the disk drive;*

selectively executing a program corresponding to the type that the medium identification information represents, the execution being actuated by a starting program recorded on the recording medium (column 5 lines 42-50, column 6 lines 44-54), *wherein if the disk drive serial number (hardware identification number) is the same as the target serial number (medium identification number) stored on the medium then the software is installed;* and

performing an error process when a hardware identification information does not represent hardware that the medium identification information represents (column 6 lines 10-16), *wherein if the serial numbers do not match, the software is not installed;* and

wherein the designated program is automatically executed in response to a recording/reproducing apparatus detecting the medium identification information on the recording medium (column 4, lines 10-35), *wherein in response to the detection of the medium identification information (serial number) on the data recording medium (software distribution medium) that the designated program (upgraded or new software program) is executed (installed).*

Claim 9 is rejected as applied above in rejecting claim 3. Furthermore, Weiler discloses:

The data recording medium according to claim 3, wherein said starting program is further configured to verify the medium identification information and a presence of a hardware device (column 5 lines 42-50, column 6 lines 44-54), *wherein if the disk drive serial number (hardware identification number) is the same as the target serial number (medium identification number) stored on the medium then the software is installed.*

Claim 11 is rejected as applied above in rejecting claim 3. Furthermore, Weiler discloses:

The data recording medium according to claim 4, wherein at least one of the plurality of programs is application software for use with the hardware device (Figure 4, column 3 line 64 – column 4 line 8), *wherein the programs, in one embodiment, are used to download software for a voicemail server.*

Claim 12 is rejected as applied above in rejecting claim 3. Furthermore, Weiler discloses:

The data recording medium according to claim 3, wherein the medium identification information includes hardware recognition information (column 5 lines 42-50, column 6 lines 44-54), *wherein if the disk drive serial number (hardware identification number) is the same as the target serial number (medium identification number) stored on the medium then the software is installed.*

Claim 13 is rejected as applied above in rejecting claim 12. Furthermore, Weiler discloses:

The data recording medium according to claim 12, wherein one of the plurality of programs is started based on at least one of a presence or recognition of a hardware device (column 5 lines 42-50, column 6 lines 44-54), *wherein if the disk drive serial number (hardware identification number) is the same as the target serial number (medium identification number) stored on the medium then the software is installed.*



Claim 14 is rejected as applied above in rejecting claim 6. Furthermore, Weiler discloses:

The data recording medium according to claim 6, wherein the medium identification information includes hardware recognition information (column 5 lines 42-50, column 6 lines 44-54), *wherein if the disk drive serial number (hardware identification number) is the same as the target serial number (medium identification number) stored on the medium then the software is installed.*

Claim 15 is rejected as applied above in rejecting claim 13. Furthermore, Weiler discloses:

The data recording medium according to claim 13, wherein said selectively starting includes a starting of one of the plurality of programs based on at least one of a presence or recognition of a hardware device (column 5 lines 42-50, column 6 lines 44-54), *wherein if the disk drive serial number (hardware identification number) is the same as the target serial number (medium identification number) stored on the medium then the software is installed.*

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiler et al. (U.S. Patent 6,725,205) in view of Tanaka (U.S. Patent 6,721,879).

Claim 10 is rejected as applied above in rejecting claim 3. Weiler discloses a plurality of programs stored on a CD-ROM. Weiler does not explicitly disclose that one of the programs is an instruction manual. Tanaka discloses using a user manual to provide the user with guidance in setting up and using the software and/or the hardware (column 13 line 64 – column 14 line 10). In one embodiment of Weiler, a voice mail application is downloaded on a hardware device. It was well-known in the art that user-manuals are stored and associated with devices to aid users in navigating and using a particular hardware device as is disclosed by Tanaka. Furthermore, Weiler is not limiting in his definition of “software” so the programs could include a user manual which could be displayed on the user interface (Figure 1, item 14). Therefore, it would have been obvious to provide a user manual as one of the plurality of programs used by Weiler to guide the user through the functions of the software as disclosed in Tanaka (column 14 lines 1-10).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAVEH ABRISHAMKAR whose telephone number is (571)272-3786. The examiner can normally be reached on Monday thru Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kaveh Abrishamkar/  
Examiner, Art Unit 2131

/K. A./  
05/14/2008  
Examiner, Art Unit 2131